

REMARKS

The Examiner rejected all pending claims. Applicant hereby amends claims 1, 13-16, 18-20, 26, 29, 31-42, 47-48 and 54-60 to more clearly define the inventive subject matter.

The Examiner objected to the drawings. The set of drawings submitted on 5/11/04 inadvertently lacked the text in item 310, and a portion of the text in item 412. Applicant apologizes for the error, and submits herewith a set of replacement drawings that rectify the omissions. No new matter is added, as the omitted text appeared in the informal drawings originally filed with the application, and was only omitted in the formal drawings submitted on 5/11/04.

The Examiner rejected claim 1, 22 and 42 on non-statutory obviousness-type double patenting over claims 1, 12 and 15 of U.S. Patent No. 6,714,793. Applicant respectfully traverses this rejection. The Examiner states that pending claims claim 1, 22 and 42 are not patentably distinct from claims 1, 12 and 15 of U.S. Patent No. 6,714,793 because "the scope of the narrower claims in the Patent anticipates the broader claims of the current pending application." Applicant respectfully notes that the Examiner fails to "make clear (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim **>at issue would have been< an obvious variation of the invention defined in a claim in the patent," as required by MPEP 804(II)(B)(1).

Applicant notes that Claim 1 as amended recites "receiving an electronic message addressed to a telephone number...determining whether an instant message receiver is

available to receive messages addressed to the instant message identifier...and [either] forwarding the electronic message as an instant message... to the instant message identifier...[or] sending the electronic message to a mobile device at the telephone number” based on whether or not an instant message receiver is currently available. In other words, a received electronic message is routed either to an instant message receiver or to a mobile device at a telephone number, based on whether an instant message receiver is available to receive the instant message.

On the other hand, claims 1, 12 and 15 of U.S. Patent No. 6,714,793 recite routing an instant message from a mobile device, through a wireless connection, to an instant message system on a computer. If the target address is associated with a user, the instant message system routes the instant message to that user. These claims do not recite, disclose or suggest routing a message to a mobile device at all, much less determining whether to route the message either to an instant message receiver or to a mobile device at a telephone number, based on whether an instant message receiver is available. Pending claim 22 is an apparatus claim similar in scope to claim 1, and pending claim 42 is a program storage medium claim similar in scope to claim 1. Thus, claims 22 and 42 allowable over the claims of the cited Patent for at least the same reasons as claim 1.

Applicant fails to see how, and explicitly traverses any assertion that, the claims of the Patent anticipate the pending claims or render the pending claims as an obvious variant of the invention defined therein. Applicant respectfully requests that the Examiner withdraw the double patenting rejection, or explain how “(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and (B) The reasons why a person of ordinary skill in the

art would conclude that the invention defined in the claim **>at issue would have been< an obvious variation of the invention defined in a claim in the patent,” as required by MPEP 804(II)(B)(1).

The Examiner rejected claims 1-61 under 35 U.S.C. 101 as lacking patentable utility. Applicant respectfully traverses this rejection. The Examiner states “the claim[s] fail to produce according to all possible scenarios a ‘specific machine to produce a useful, concrete, and tangible result’.” Applicant respectfully notes that the Examiner fails to provide a “full development of the reasons [for such rejection] rather than a mere conclusion coupled with some stereotyped expression,” as required by MPEP 706.03. Specifically, the Examiner fails to offer any explanation of what claims fail to produce “a useful, concrete, and tangible result,” or why not.

Claim 1 as amended recites “receiving an electronic message addressed to a telephone number...determining whether an instant message receiver is available to receive messages addressed to the instant message identifier...and [either] forwarding the electronic message as an instant message... to the instant message identifier...[or] sending the electronic message to a mobile device at the telephone number” based on whether or not an instant message receiver is currently available. This is a useful, concrete, and tangible result, produced under all circumstances. The method will either forward the electronic message to an instant message receiver or to a mobile device, depending upon whether an instant message receiver is available. Either way, a tangible useful result occurs: an electronic message is transmitted to a desired target. The method is concrete in that depending upon a specific determination (whether an instant message receiver is

available), the method will execute one step or the other (send message to instant message receiver or send message to mobile device).

Claims 2-21 dependent from claim 1 and are thus useful for at least the same reasons as claim 1. Claims 22-41 are apparatus claims similar in scope to claims 1-21, and are thus useful for at least the same reasons as claims 1-21. Claims 42-61 are program storage medium claims similar in scope to claims 1-21, and are thus useful for at least the same reasons as claims 1-21.

Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. 101 rejection, or provide a “full development of the reasons [for such rejection] rather than a mere conclusion coupled with some stereotyped expression,” as required by MPEP 706.03.

The Examiner rejected claims 1-61 under 35 U.S.C. 102 as being anticipated by Mache. Applicant respectfully traverses this rejection. Claim 1 as amended recites “receiving an electronic message addressed to a telephone number...determining whether an instant message receiver is available to receive messages addressed to the instant message identifier...and [either] forwarding the electronic message as an instant message... to the instant message identifier...[or] sending the electronic message to a mobile device at the telephone number” based on whether or not an instant message receiver is currently available. In other words, a received electronic message is routed either to an instant message receiver or a mobile device, based on whether an instant message receiver is available to receive an instant message. More specifically, claim 1 recites receiving an electronic message that is addressed to a telephone number, locating an instant message identifier associated with that telephone number, and determining to

where to send the message depending upon whether an instant message receiver is available to receive instant messages sent to the instant message identifier associated with the telephone number. If so, the electronic message is sent to the instant message receiver. If not, the electronic message is sent to a mobile device at the telephone number. Thus, when a user is available to receive instant messages, incoming messages are sent to the user; when the user is unavailable, the messages are routed to the user's mobile device (e.g., cell phone).

The above described limitations are neither disclosed nor suggested by Mache. Instead, Mache describes receiving a message in any format, and translating the message into a universal format (UIM) for routing through a network. The message is then converted into a device appropriate format based on the target recipient, and routed to the appropriate device. See [0035]-[0039]; [115]. Thus, an incoming message addressed to an instant message receiver would presumably be sent to the instant message receiver, and an incoming message addressed to a mobile device would presumably be routed to the mobile device, but nothing in Mache discloses or suggests determining whether an instant message receiver is available at all, much less sending an individual message to an instant message receiver or a mobile device at a telephone number depending upon whether the target user is available to receive instant messages.

The Examiner suggests, without explanation, that Mache discloses determining whether an instant message receiver is available to receive instant messages at [51].

Mache [51] in its entirety states:

FIG. 3 shows the Instant Message Broker (IMB) internals. The internal units of the instant message broker 1 administer user profiles, manages accounting, billing, authentication and security. A configuration unit

dynamically traces the state and the properties of gateways, message processors and partner brokers. Dependent on message type, originator and sender location, user profiles and available resources the instant message required conversion is determined and the instant message is routed from the originator gateway to the destination gateway.

Nothing in the above quoted text (or in Figure 3) mentions or hints at determining whether an instant message receiver is available to receive instant messages, as recited by claim 1. Applicant has studied Mache in great detail and respectfully posits that such a limitation is neither suggested nor disclosed anywhere else in Mache either. As making such a determination is not disclosed, it follows that Mache does not disclose sending a message to A) an instant message receiver or B) to a mobile device associated with a telephone number, based on the results of said determination.

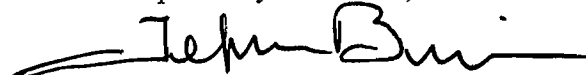
Mache does discuss “selecting an appropriate transfer medium out of a plurality of transfer media... depending on the target network, the message type and/or client preferences.” [19][20]. However, Mache’s determination of “transfer media” is in no way equivalent to the recited determination of where to send the message. Mache’s determination of “transfer media” comprises making a choice as to which medium to use in order to transmit a message to whatever its destination happens to be. The only specific examples of “transfer media” given by Mache are “transfer media can comprise analog and digital transfer media.” [12]. The relevant limitation of claim 1, on the other hand, recites determining to where to send an individual message targeted to a user, not over which media to transport the message. Furthermore, Mache does not suggest or disclose determining which “transfer media” to use based on the availability of a user, but instead “depending upon the target network, the message type and/or client preferences.”

These distinctions are substantive. Mache enables transmitting messages between sources and destinations of varying formats by using a common internal message format. Applicant's invention as recited by claim 1 concerns determining whether to send an individual message addressed to a specific target to an instant message receiver or a mobile device associated with a telephone number, based upon whether the user is available to receive instant messages. These are different problems, and as explained above they are solved in different ways, through the use of different mechanisms and methodologies.

Claims 2-21 dependent from claim 1 and are thus novel for at least the same reasons as claim 1. Claims 22-41 are apparatus claims similar in scope to claims 1-21, and are thus novel for at least the same reasons as claims 1-21. Claims 42-61 are program storage medium claims similar in scope to claims 1-21, and are thus novel for at least the same reasons as claims 1-21. Although moot in light of the above, for the record Applicant respectfully traverses the Examiner's assertion that the additional recited limitations of the dependent claims are anticipated by Mache.

Applicant respectfully posits that all objections to and rejections of the pending claims have been overcome. Accordingly, Applicant respectfully requests allowance of all claims as amended. If the Examiner would like to discuss this matter, Applicant's attorney can be reached at 650-474-8400.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jeffrey Brill", with a long horizontal flourish extending to the left.

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